For a claimed invention to be obvious over a combination of prior art references, there must be some suggestion, motivation or teaching in the prior art that would have led one of ordinary skill in the art to combine the references to produce the claimed invention. *E.g., Ashland Oil, Inc. v. Delta Resins & Refracs.*, 776 F.2d 281, 293 (Fed. Cir. 1985). In this regard, the Federal Circuit has warned against using the claimed invention as a "blueprint" for piecing together elements in the prior art to defeat the patentability of a claimed invention:

> As this court has stated, "virtually all [inventions] are combinations of old elements." . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."

In re Rouffet, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). (Citations omitted). The Federal Circuit has identified three possible sources for a motivation to combine references:

> To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the matter claimed. This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

Id. at 1457-58 (Fed. Cir. 1998).

The claimed invention of the present application is not obvious over the cited references because, in combining the plurality of cited references to reject various claims, the Examiner does not rely on any of the three possible sources of motivation to combine references identified by the Federal Circuit. Rather, the Examiner impermissibly uses the claimed invention as a blueprint to piece together elements from a plurality of references in an effort to produce the claimed invention.

But, even assuming, *arguendo*, that the Examiner properly combined the cited references, the resulting combination would still not be the claimed invention, given the deficiencies in the cited references noted below.

All of the independent claims of the present application, *i.e.*, claims 1, 12, 15 and 17, recite (1) an identification element carried by an electrosurgical instrument including at least two electrodes, and being representative of at least the number of electrodes present on the instrument, and (2) a switching circuit having at least three output connections, with at least two being in electrical connection with respective ones of the at least two electrodes, and being operated to connect generator RF output lines to two or more of the at least three output connections, depending on the particular identification element carried by the instrument. None of the cited references, either alone or in combination, disclose these features recited in independent claims 1, 12, 15 and 17 of the present application.

The primary Denen *et al.* reference relied upon by the Examiner in his rejection of the claims discloses a memory 30 disposed within electrically powered medical equipment 31, such as an electrically powered scalpel 10, which stores certain identification data, parametric data and utilization limits for the equipment 31. The identification data is described as including a

serial number for uniquely identifying equipment, a model number for identifying the equipment type, and other proprietary data programmed by the manufacturer. Denen *et al.*, col. 8, lns. 47-54. Denen *et al.* do not include the number of instrument electrodes in their description of the identification data.

The parametric data is described as being used by a control module 36 to control the operation of a power supply module 39 to conform with the power supply requirements of equipment 31. Denen *et al.*, col. 9, lns. 14-18. Thus, the preprogrammed parametric data may be used to establish electrical fault limits for equipment 31, so that current or voltage limits can be established and a fault condition indicated where a high current or voltage duration greater than a predefined value occurs. The parametric data can also include a fault count limit, which, if exceeded, results in equipment deactivation. Denen *et al.*, col. 9, ln. 55 to col. 10, ln. 18. Denen *et al.* do not include the number of instrument electrodes in their description of the parametric data.

The utilization limits can include a maximum procedure count, a maximum equipment actuation count, a maximum equipment actuation time and a maximum sterilization count. Denen *et al.*, col. 10, ln. 38-45. Here again, Denen *et al.* do not include a number of instrument electrodes in their description of the utilization limits data.

Denen *et al.* do not disclose a device with more than two electrodes, and thus they do not disclose switching between electrodes, much less doing so depending on the mode of operation of the medical equipment, such as cutting or coagulation by an electrosurgical instrument. The Examiner recognizes that Denen *et al.* do not disclose "a switching circuit having at least three output connections, each of at least two of which being an electrical connection with a respective

one of the at least two electrodes." 4/25/06 Office Action, p. 4. To compensate for this deficiency in the teachings of Denen *et al.*, the Examiner looks to column 19, lns. 13-46 of Hareyama *et al.*, which references Figure 31 of such reference. But Hareyama *et al.* do not disclose any identification feature whatsoever with respect to the three electrode device referenced in Figure 31. As such, combining Hareyama *et al.* and Denen *et al.* would not produce the claimed invention, since nothing in Denen *et al.* discloses an identification feature for identifying the number of electrodes in an instrument attached to a generator, much less the operation of a switching circuit that is controlled according to the identification element, and thus, the number of electrodes present on an instrument, as recited in the independent claims of the present application.

None of the tertiary references cited by the Examiner compensates for the noted deficiencies in the teachings of the Denen *et al.* and Hareyama *et al.* references discussed above.

In his rejection of claims 2-4 and 17, the Examiner adds the German patent application of Klett *et al.* to the combination of Denen *et al.* and Hareyama *et al.* as disclosing identification of elements in the form of a resistor, capacitor or inductor. Whether Klett *et al.* disclose such identification elements, the Examiner fails to point to some suggestion, motivation or teaching in the cited references that would have led one of ordinary skill in the art to combine the references, as argued by the Examiner. Nevertheless, Klett *et al.* do not compensate for the deficiencies in the teachings of Denen *et al.* and Hareyama *et al.* in that, as noted in the Amendment filed January 20, 2006, the German patent to Klett *et al.* discloses a surgical system that includes a high frequency generator for generating high frequency voltages and a plurality of high frequency surgical instruments that may be connected simultaneously or sequentially to the high

frequency generator. The high frequency generator is described as having different operating modes for cutting and/or coagulating. The high frequency surgical instruments are described as mono-functional, bi-functional, or multifunctional instruments for monopolar, bipolar, or quasi-bipolar cutting and/or coagulating of tissue. The surgical instruments are further described as being equipped with an electric or electronic coding device that is connected to a decoding device which converts the coding of the surgical instruments into electric signals used to configure the high frequency generator to a mode of operation corresponding to the respective coding of the instrument or instruments connected to the generator. Thus, Klett *et al.* disclose a generator system with an electrode identification capability. They disclose the identification of monopolar and bipolar instruments, and whether those instruments are for cutting or coagulating (or both). They do not specifically disclose the identification of instruments with more than two electrodes, much less any system having the capability of switching the electrodes to which different signals are delivered. In the prior Office Action of October 20, 2005, the Examiner acknowledged that Klett *et al.* do not disclose a switching circuit as recited in independent claims 1 and 17, of the present application. This switching circuit as recited is now also recited in remaining independent claims 12 and 15 of the present application.

In his rejection of claims 11 and 14, the Examiner also argues that it would have been obvious to modify the combination of Denen *et al.* and Hareyama *et al.* with the hook structure of Roos to provide a cutting and coagulating electrosurgical device for laparoscopic surgery. Here again, the Examiner fails to point to some suggestion, motivation or teaching in the cited references that would have led one of ordinary skill in the art to combine the references as argued by the Examiner. Nevertheless, Roos also does not compensate for the deficiencies in the

teachings of Denen *et al.* in that Roos discloses an electrosurgical device including three mutually insulated contact rods 11, 12 and 13 arranged in a guide tube 14, with two of the contact rods 12 and 13 having at their free ends coagulation electrodes 22 and 23 and the center rod 11 serving as a cutting electrode 21.

Finally, in his rejection of claims 12, 13, 15 and 16, under §103(a), the Examiner adds the Latteral *et al.* patent to the combination of Denen *et al.* and Hareyama *et al.* With regard to claims 12 and 15, the Examiner argues that it would have been obvious to modify the combination of Denen *et al.* and Hareyama *et al.* with hook like electrodes of Laterral *et al.* to provide enhanced cutting and coagulation capability over existing hook-probe instruments. With regard to claims 13 and 16, the Examiner argues that Latterell *et al.* disclose a centrally positioned electrode extending distally beyond the other electrodes and an electrode that is centrally positioned between the other electrodes that is movable. Here again, the Examiner fails to point to some suggestion, motivation or teaching in the cited references that would have led one of ordinary skill in the art to combine the references as argued by the Examiner. Nevertheless, Latterell *et al.* also do not compensate for the deficiencies in the teachings of Denen *et al.*, in that they disclose a bipolar electrosurgical hook probe including an end effector with first and second electrodes placed in parallel, closely spaced relationship, each being of a relatively large surface area, and a conductive reciprocally movable hook member that is movable into and out of a space between the first and second electrodes. Although Latterell *et al.* disclose a switch mechanism by which an RF current can alternatively be made to flow between the first and second electrodes during coagulation and from the hook electrode to each of the first and second electrodes in a cutting mode, it does not disclose an identification element

representative of the number of electrodes present on an instrument or a switching circuit that is operated to connect to two or more of at least three output connections, depending on the particular identification element carried by an instrument, as recited in the independent claims of the present application.

Thus, clearly, independent claims 1, 12, 15 and 17 of the present application are not obvious in view of the teachings of the several references cited by the Examiner in his §103(a) rejections. And, because independent claims 1, 12, 15 and 17 of the present application are not obvious in view of the several references cited by the Examiner, the dependent claims which depend from these independent claims, *i.e.*, claims 2-5, 11, 13, 14, 16 and 18, are also not obvious in view of such references.

In view of the foregoing, it is believed that all of the claims pending in the application, *i.e.*, claims 1 – 5 and 11 – 18 are now in condition for allowance, which action is earnestly solicited. If any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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